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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PANNALA, SATHYANARAYA R

ART UNIT

PAPER NUMBER

2164

MAIL DATE

DELIVERY MODE

02/04/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/776,370

**Applicant(s)**

ACHESON ET AL.

**Examiner**

Sathyannarayan Pannala

**Art Unit**

2164

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-10, 16-20 and 26-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-10, 16-20 and 26-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/14/2008 has been entered.

### ***Response to Amendment***

2. Applicant filed an RCE on 11/13/2008 requesting consideration of amendment filed on 8/14/2008 has been entered including amended claims 6-10, 16-20, 26-30, newly added claims 31-48 and cancelled claims 1-5, 11-15, 21-24. In this Office Action, claims 6-10, 16-20, 26-48 are pending.

### ***Specification***

3. The specification amendment filed on 11/13/2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: **The amendment is treated as a new matter will not be entered, because Applicant is adding 3 additional paragraphs.**

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 36 is rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled "Clarification of 'Processes' under 35 U.S.C. 101"). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps of invoking managed code, exposing the invocation context and executing the managed code, which can all be done mentally, and therefore do not qualify as a statutory process.

Claims 6-10 and 32-36 are rejected under 35 U.S.C. 101 as being dependent on an independent claim 31, which has been rejected under 35 U.S.C. 101.

6. Claims 16-20, 37-42 are rejected under 35 U.S.C. 101 the claimed invention is directed to non-statutory subject matter. Claim 37 as a whole constitutes merely a software program that have recited as being embodied on a medium that a computer may access and not realized the functionality of a program. Therefore the claims 16-20 and 37-42 are non-statutory and ineligible for a patent. See *Diehr*, 450 U.S. at 186 and *Gottschalk v. Benson*, 409 U.S. 63, 71-72 (1972).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 6-10, 16-20 and 26-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pastor (US Patent 6,681,383) hereinafter Pastor, and in view of Harris (USPA Pub. 2002/0059204 A1) hereinafter Harris.

9. As per independent claims 31, 37 and 43, Pastor teaches an automated software production tool, software, and methodology. In which a graphical user interface is presented to allow a user to input unambiguous formal requirements for the software application. Based on the formal requirements input for the software application, a formal specification for the software application is produced and validated, from which the software application is generated. By generating the software application directly from an unambiguous, validated formal specification, the software developer can avoid the programming errors associated with conventional programming languages, and instead work directly in the problem space (col. 3, lines 51-62). Pastor teaches the claimed, invoking .NET managed code and an invocation context in the database server (Examiner interpreted .NET is based on Visual Basic VB) (Fig. 2, col. 7, lines 50-51 and 58-59). Pastor teaches the claimed, writing said application code as .NET managed code (Fig. 2, col. 7, lines 51-55). Pastor does not explicitly teach invocation context to the database server. However, Harris teaches the claimed, exposing the invocation context to the database server through the utilization of an in process provider (page 8, paragraph [0074]). Harris teaches the claimed, executing the .NET managed code in the database server based on the invocation context (page 6, paragraph [0062]). Thus, it would have been obvious to one of ordinary skill in the data

processing art at the time of the invention, to have combined the teachings of the cited references because Harris' teachings would have allowed Pastor's method to Supplier networks may dynamically access information from relevant suppliers in the response to the buyer's requirements and present only the suppliers and products that precisely meet the consumer's needs (page 1, paragraph [0006]).

10. As per dependent claims 34, 40, 46, Pastor teaches the claimed, instructions for separating the .NET managed code into an immutable part and a mutable part and, instructions for executing the .NET managed code based on the results of the operation of separating (Fig. 4, page 6, paragraph [0062]).

11. As per dependent claims 36, 42, 48, Pastor teaches the claimed, the in-process provider supports more than one pending executing command for a client connection (Fig. 1, col. 5, lines 11-16).

12. As per dependent claims 35, 41, 47, Pastor teaches the claimed, invoking .NET managed code in the database server is a result of a client trigger (col. 34, lines 32-35).

13. As per dependent claims 32, 38, 44, Pastor teaches the claimed, exposing the invocation context comprises exposing at least one of : a client's connection context, a command with a state execution context, a transaction context associated with a command, a path through which requests and **results may be sent or received**

**between a client and database server**, a trigger context, where the trigger results from an operation of the client, or a forward-only cursor on top of statement execution results (Fig. 2, col. 7, lines 52-59).

14. Claims 33, 39 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pastor (US Patent 6,681,383) hereinafter Pastor, in view of Harris (USPA Pub. 2002/0059204 A1) hereinafter Harris, and in view of Woodring (US Patent 7,020,660) hereinafter Woodring.

15. As per dependent claims 33, 39 and 45, Pastor and Harris do not explicitly teach using ADO. However, Woodring teaches the claimed, the client comprises a .NET application and the in-process provider is an ADO.net in-process provider (Fig. 3, col. 3, lines 49-56). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Harris' teachings would have allowed Pastor's method to eliminate the application software code customization based on a low level DBMS application programming interface (API) and the specific DBMS being accessed. (col. 1, lines 28-31).

### ***Response to Arguments***

16. Applicant's arguments filed 11/13/2008 have been fully considered but they are not persuasive and details as follows:



a) Applicant's argument regarding 35 U.S.C 101 rejection, stated as "Applicants added independent claims 31, 37, and 43 in accordance with the suggestion made by the Examiner."

In response to Applicant's argument, Examiner respectfully disagrees, because the amendment did not overcome the rejection and indicates that the amendment is not done properly.

b) Applicant's argument regarding 35 U.S.C 103 rejection of claims 1 and 11, stated as "Paster does not teach .NET managed code."

In response to Applicant's argument, Examiner respectfully disagrees, because the Examiner has clearly stated in the rejection of claims as "Examiner interpreted .NET is based on Visual Basic VB." In fact VB is a part of the programming language in .NET managed code. Applicant amendment did not change the claims and merely cancelled and added in the same concept. Therefore, the rejection is maintained.

### **Conclusion**

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sathyanarayan Pannala whose telephone number is (571) 272-4115. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2164

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sathyanarayan Pannala/  
Primary Examiner, Art Unit 2164

srp  
February 2, 2009